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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/333,894	06/14/1999	ARSHISH Cyrus KAPADIA	0544MH-3426	4656

7590 01/30/2002

ATTEN: CHRISTOPHER W. KENNERLY, ESQ.
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EXAMINER

KERR, DEBRA E

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

Office Action Summary	Application No.	Applicant(s)	
	09/333,894	KAPADIA ET AL.	
	Examiner	Art Unit	
	Debra E Kerr	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Dudle et al. (US Patent No. 5,570,291).

As per claims 1, 2 and 10, Dudle et al. disclose a method for configuring a product, comprising the steps of defining a configuration preference for a session in which a user configures a product (col. 18, lines 4-15), presenting a series of selection option sets to the user, each set containing at least one item (col. 11, line 57 – col. 12, line 11), determining for each set which of the items are available and presenting only those items which are available (col. 12, lines 51-60), accepting from the user a selection of an item from the set, wherein selection of an item from each set defines a configuration for the product (col. 12, lines 12-38 and col. 17, lines 12-18), for each set, before presenting a set of selections to the user, determining which of the items are actually available and presenting only those items which are actually available (col. 12, lines 39-41 and 55-60 and col. 17, lines 7-10), presenting a default selection from the set (col. 17, lines 28-59) which provides a best fit with the preference (col. 18, lines 6-14), and for each set in which a default selection is identified, selecting as the default

an item which is actually available and which provides a best result to a preselected optimization function (col. 17, lines 33-49 and lines 50-59).

As per claim 3, Dudle et al. disclose a method wherein the step of presenting a default selection includes defining a default selection which provides a good fit with an optimization function in addition to the best fit with the preference (col. 19, lines 13-21).

As per claim 4, Dudle et al. disclose a method wherein the optimization function maximizes manufacturer profit (col. 18, lines 58-61 and col. 19, lines 13-21).

As per claims 5 and 6, Dudle et al. disclose a method wherein the preference selects an item having a low price (col. 14, lines 18-25).

As per claim 7, Dudle et al. disclose a method wherein the preference is defined during the session (col. 13, line 33-44).

As per claim 8, Dudle et al. disclose a method wherein the preference is defined in response to an identification of the user (col. 13 lines 54-57, col. 14, lines 7-8 and col. 15, lines 60-63).

As per claim 9, Dudle et al. disclose a method wherein the preference is defined in response to a product selection decision made by the user (col. 17, lines 50-62 and col. 19, lines 6-12).

As per claim 11, Dudle et al. disclose a method of defining configuration information to provide a series of selection sets to be presented to configure the product before any selection sets are presented to the user (col. 11, lines 7-11 and col. 12, lines 43-49), and determining which of the items in the defined configuration information are actually available (col. 12, lines 55-60).

As per claim 12, Dudle et al. disclose a method wherein, as selections are made by the user, adding constraints to later presented selection sets (col. 12, lines 40-42 and col. 17, lines 40-44 and lines 57-60), and within the determining step, determining which of the items in the defined configuration information and which meet constraints added by user selections, are actually available (col. 17, lines 64-67 and col. 18, lines 6-8).

As per claim 13, Dudle et al. disclose a method wherein the optimization function is selected during a session with the user in which the product configuration is performed (col. 18, lines 35-41).

As per claim 14, Dudle et al. disclose a method wherein the optimization function is selected as a function of an identity of the user (col. 14 lines 8-14 and 20-25).

As per claim 15, Dudle et al. disclose a method wherein the optimization function is selected by the user (col. 17, lines 40-43).

As per claim 16, Dudle et al. disclose a method wherein the default item is selected which provides a best result to a second optimization function and the first optimization function (col. 17, lines 55-64).

As per claim 17, Dudle et al. disclose a method wherein the preselected optimization function is a function which minimizes price to the user (col. 19, lines 6-12).

As per claim 18, Dudle et al. disclose a method wherein the preselected optimization function is a function which maximizes profit to a manufacturer (col. 19, lines 13-21).

As per claim 19, Dudle et al. disclose a method wherein the preselected optimization function is a function which minimizes time to delivery of the product (col. 18, lines 55-61 and col. 8, lines 19-24).

As per claim 20, Dudle et al. system for configuring products comprising a user interface for displaying lists of items to a user and accepting selections from the user, wherein for at least one list a default item is indicated to the user (col. 12, lines 40-42 and col. 17, lines 33-36 and line 49), and an engine which stores information indicating product availability (col. 17, lines 12-18 and col. 18, lines 17-21), wherein the engine provides lists of items to the user interface for display (col. 18, lines 13-15), and which determines the default item on a list (see standard base composition charge, col. 17, lines 55-57) by applying an optimization function to the product availability information (see rules applied to generic price matrices to select best fit price matrix to be used in determining the standard base composition charge, col. 18, lines 6-8) .

As per claim 25, Dudle et al. disclose a system which comprises an optimization function for minimizing product price (col. 18, lines 4-11 and lines 35-41, col. 19 lines 6-12).

As per claim 26, Dudle et al. disclose a system which comprises an optimization function for maximizing profits (col. 19, lines 13-21).

As per claim 27, Dudle et al. disclose a system which comprises an optimization function for minimizing delay until the product is ready (col. 8, lines 18-24).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dudle et al. (US Patent No. 5,570,291) in view of Kennedy (US Patent No. 6,188,989).

As per claims 21 and 22, Dudle et al. substantially discloses the invention as claimed, including a separate engine which returns a list of available items to the configuration engine (see corporate price matrix database, col. 4, lines 7-14 and col. 18, lines 8-11), but fail to disclose the separate engine being an available to promise engine. Kennedy et al. teach an available to promise engine (col. 2, lines 18-23) containing request information for a product including quantities of a product and the dates it is needed on (col. 2, lines 48-52). It would have been obvious to one having ordinary skill in the art to combine Dudle's product estimating system with Kennedy's system for managing available to promised product so that Dudle's system could make use of an ATP engine that applies forecast data when determining available items on a list, thereby ensuring that Dudle et al. 's system performs optimization calculations on

the most accurate list of available items possible, and doesn't waste the user's time by displaying for selection an item that may be unavailable when the user actually needs it.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dudle et al. (US Patent No. 5,570,291) in view of Kennedy (US Patent No. 6,188,989), and further in view of Cram (US Patent No. 5,963,953).

Dudle et al. substantially teach the invention but fail to teach a configuration engine passing a list of items to an available to promise engine which applies the optimization function to the actually available items before returning the list of available items, with an identification of the item which best matches the optimization function, to the configuration engine. Kennedy teaches an available to promise engine which applies optimization functions to a list of available items (col. 7, lines 33-49), including an extensible product model which applies expected variance in item quantity or availability dates to be input and used in forecast orders (col. 7, line 67 - col. 8, line 25). It would have been obvious to one having ordinary skill in the art to combine Dudle et al.'s product estimating system with Kennedy's system for managing available to promised product in order for Dudle et al.'s system to increase system efficiency by having a remote ATP engine determining product availability and performing optimization calculations in one step, thus eliminating the need for Dudle et al.'s configuration engine to perform any calculations on the data before displaying an accurate product list for the user to select from.

Dudle et al. and Kennedy fail to teach an available to promise engine which identifies the default item when the product list is returned to the configuration engine.

Cram et al. teach a system which selects the preferred item on a list based on an optimization function (see algorithm used to select highest-margin product as the default, col. 7, lines 5-11), and identifies the default item when the list is returned (col. 4, lines 23-29). It would have been obvious to one having ordinary skill in the art to combine Dudle et al.'s product estimating system and Kennedy's system for managing available to promised product with Cram et al.'s product configuration system to identify the available item on a list which most closely matches a user's criteria, instead of requiring the user to guess or do further research into the most appropriate item to select.

Please note that Dudle et al., Kennedy and Cram et al. fail to teach a configuration engine passing a list of proper configuration items to an available to promise engine. Official notice is taken that it is well known in the computer art to pass a parameter list of data from a first computer to a second computer, which performs calculations on the data and then passes the parameter list back to the first computer.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Puri (US Patent No. 6,064,982) discloses a smart configurator.

Pinder et al. (US Patent No. 6,086,377) discloses a system and method for product and service configuration.

Gupta et al. (US Patent No. 5,825,651) discloses a method and apparatus for maintaining and configuring systems.

Andersen et al. (US Patent No. 5,774,883) discloses a method for selecting a seller's most profitable financing program.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra E Kerr whose telephone number is (703) 305-3184. The examiner can normally be reached between 7 a.m. and 4:30 p.m., Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 305-1440. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.

DEK
January 28, 2002


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